



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/777,904

02/13/2004

Jun Hirai

248884US6

6087

22850

7590

07/11/2011

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

DEGA, MURALI K

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

07/11/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,904	<b>Applicant(s)</b> HIRAI ET AL.	
	<b>Examiner</b> MURALI DEGA	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office action is in response to the remarks filed on 23 March 2011, in reply to the previous Office action mailed on 23 December 2010.
2. Claims 1-12 are pending.
3. Claims 1-12 have been examined.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hiratsuka (U.S. 2004/0064380) in view of Sako et al. (U.S. 2003/0012098).
3. With respect to claims 1 and 12:
4. Hiratsuka discloses a contents copying management system ("Overall view of the system", Fig. 1) configured by connecting ("Communication network CN") a contents copying apparatus ("Personal computers" PCa1, PCa2,...) and a copying management device ("Server SV") by a network ("Communication network CN"), said contents copying apparatus comprising:

- a. the controller ("CPU 1 centrally performs various controls", ¶ [0024]) further configured to acquire apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) specific to and indicating said contents copying apparatus itself;
- b. a first transmission/reception section ("Communication interface", item 8 of Fig. 1B) that transmits ("send user information", step P1, Fig. 4A) said medium identifying information and said apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]) to said copying management device ("Server SV") as copying-related combination information;
- c. the first transmission/reception section ("Communication interface", item 8 of Fig. 1B) further receives copying authorizing information ("control data Dc", ¶ [0007]) generated by said copying management device ("Server SV") on the basis of said copying-related combination information at the time of accessing said copying management device, after transmitting said medium identifying information ("server apparatus SV sends the copy control data Dc of the relevant contents as a reply", ¶ [0007])
- d. and the controller ("CPU 1 centrally performs various controls", ¶ [0024]) further configured to control an operation of copying said contents from said original recording medium in response to said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007])

- e. said copying management device ("Server SV") comprising:
- f. a database ("storing device 4 of the server SV stores", ¶ [0031]) that registers and stores ("the server SV stores personal information regarding each of the numerous users US (a, b, c, . . . ) registered in the server SV as user information Du...", ¶¶ [0031], [0044]-[0046]) said copying-related combination information ("Du, Db and Dc, Fig. 2) received from said contents copying apparatus ("Personal computers" PCa1, PCa2,...) in advance ("registered in advance", [0007] and [0040]);
- g. a control section ("Server SV") configured to compare said copying-related combination information ("Du, Db and Dc, Fig. 2) received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance ("registered in advance", ¶¶ [0007] and [0040]), that judges agreement or disagreement ("validated or invalidated") of said combinations of medium identifying information and apparatus identifying information ("an apparatus number (PC number)" ¶ [0018]), and that generates copying authorizing information ("control data Dc", ¶ [0007]) for authorizing an operation of copying the contents in response to agreement of said combinations but that generates copying non- authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations ("copying process is validated or invalidated in accordance with the current contents of the copy control data Dc", ¶ [0038]);

- h. and a second transmission/reception section that transmits said copying authorizing information ("control data Dc", ¶ [0007]) to said contents copying apparatus ("server SV reads the copy control data corresponding to the sent music reference number out from the music data purchase information area Db of the relevant user information Du of the storing device (HD) and sends the copy control data to the relevant terminal PC as a reply (S8)", ¶ [0056]).
- i. Hiratsuka discloses a copying controlling system using the copying apparatus number, user information and information regarding the contents to be copied ("copying of contents", ¶¶ [0007], [0008] and [0039]) but does not explicitly disclose use of medium identifying information.
- j. However Sako teaches a controller ("extracting portion" and "copy management extracting circuit", ¶¶ [0028], [0129]-[0132]) configured to acquire medium identifying information ("extracting the plurality of types of management information from the data of the content that is read from the record medium", ¶ [0027] and Claim 31) specific to and uniquely characterizing one recorded-contents-carrying original recording medium ("original medium identification information", ¶¶ [0203], [0204], and [0213]) including contents to be copied;
- k. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hiratsuka and Sako in order to provide a copy control method and system using original medium identifying information and the copying apparatus information, resulting in a more accurate and effective copy control method that prevents unauthorized copying by users and results in improved

revenues for the content producers and distributors, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

5. With respect to claim 2:

6. Hiratsuka discloses wherein said controller ("CPU 1 centrally performs various controls", ¶ [0024]) is further configured to control reproduction of said copied contents according to said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007]).

7. With respect to claim 4:

8. Hiratsuka discloses wherein said controller ("CPU 1 centrally performs various controls", ¶ [0024]) is further configured to control copying of said contents according to said copying authorizing information ("In accordance with the contents of the copy control data Dc, information processing terminal PC determines whether or not to copy the relevant contents into external apparatus", ¶ [0007]) and displays a predetermined warning image on a display when copying is not authorized according to said copying authorizing information ("the display 6 of the terminal PC display a message that "the music data cannot be sent because the music data are already copied", ¶ [0057]).

9. With respect to claim 5:

10. Hiratsuka discloses wherein said database ("storing device 4 of the server SV stores", ¶ [0031]) registers said medium identifying information ("the server SV stores

personal information regarding each of the numerous users US (a, b, c, . . . ) registered in the server SV as user information Du...”, ¶¶ [0031], [0044]-[0046]) said copying-related combination information (“Du, Db and Dc, Fig. 2) received from said contents copying apparatus (“Personal computers” PCa1, PCa2,...) according to a title of said contents on a title by title basis (“the list of items (music titles, numbers, etc.) of the already purchased music data Dmd stored in storing device 4”, ¶ [0055]) when registering and storing in advance (“registered in advance”, [0007] and [0040]) said copying- related combination information received from said contents copying apparatus and said control section is further configured to select said medium identifying information to be compared according to said title when it compares said copying-related combination information received at the time of said access of said contents copying apparatus with said copying-related combination information registered in advance in said database (¶¶[0031], [0032], [0034] and [0049] and Fig.2).

11. With respect to claims 6 and 7:

12. Hiratsuka discloses wherein said controller is further configured to generate the contents to be copied, convoluting said medium identifying information and said apparatus identifying information (“an apparatus number (PC number)” ¶ [0018]) into said contents, when copying said contents, and to control reproduction of said copied contents by taking out the medium identifying information and the apparatus identifying information from said copied contents, to transmit the combined information to said copying management device by said first transmission/reaction section and to receive said copying authorizing information generated by said copying management device on



the basis of the combination of the medium identifying information and apparatus identifying information when reproducing said copied contents (“for each of the music data (1, 2, 3, . . . ), the music information Dm is made of a music reference number (music ID number) for specifying the relevant music data, an SMF (Standard MIDI File) representing the contents of the relevant music as well as lyric data, image data, and other data corresponding to the relevant music, as illustrated in the central two columns of FIG. 2. Here, the other data of each of the music data include the copy control data Dc representing the number of times the relevant music data can be copied, as shown by broken lines in the rightmost column. However, the copy control data Dc need not be stored for each of the music data if the same number (for example “2” (at the time of downloading)) is to be set, irrespective of the music, in the copy control data Dc”, ¶ [0034]).

13. With respect to claim 8:

14. Hiratsuka discloses wherein said controller is further configured to encode the contents, using said apparatus identifying information as key, when carrying out an operation of copying said contents (“regarding the PC number, the server SV may impart a unique (single) number each time”, ¶ [0018]).

15. With respect to claim 9:

16. Hiratsuka discloses a copying management device (“Server SV”) comprising: a transmission/reception section that receives medium identifying information specific to and characterizing a recorded-contents-carrying original recording medium including contents to be copied; and apparatus identifying information (“an apparatus number (PC

number)" ¶ [0018]) specific to and indicating a contents copying apparatus itself from said contents copying apparatus as copying-related combination information at the time of copying said contents from said original recording medium by a network; a database that registers and stores said copying-related combination information received from said contents copying apparatus in advance; a control section configured to compare said copying-related combination information received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance, to determine agreement or disagreement of said combinations of medium identifying information and apparatus identifying information, to generate copying authorizing information for authorizing an operation of copying the contents from said original recording medium in response to agreement of said combinations but to generate copying non-authorizing information for not authorizing any operation of copying the contents in response to disagreement of said combinations; and the transmission/reception section further transmits said copying authorizing information to said contents copying apparatus, wherein said copying management device controlling copying of said contents by said contents copying apparatus from said recorded-contents-carrying original recording medium according to said copying authorizing information with respect to each recorded-contents- carrying original recording medium. (Also, refer to claim 1 rejection).

17. With respect to claim 10:

18. Hiratsuka discloses a copying management method comprising:

- l. a copying-related combination information receiving operation receiving medium identifying information specific to and uniquely characterizing one recorded-contents-carrying original recording medium (refer to Sako) including contents to be copied (“copying of contents”, ¶¶ [0007], [0008] and [0039]) and apparatus identifying information specific to and indicating a contents copying apparatus itself from said contents copying apparatus as copying-related combination information at the time of copying said contents from said original recording medium by a network;
- m. registering and storing (“storing”, ¶¶ [0037] and [0038]) said copying-related combination information received from said contents copying apparatus in advance;
- n. a control section (“Server SV”) configured to compare said copying-related combination information (“Du, Db and Dc, Fig. 2) received at the time of access by said contents copying apparatus with said copying-related combination information registered in said database in advance (“registered in advance”, ¶¶ [0007] and [0040]), determining agreement or disagreement (“validated or invalidated”) of said combinations of medium identifying information and apparatus identifying information (“an apparatus number (PC number)” ¶ [0018]), and that generates copying authorizing information (“control data Dc”, ¶ [0007]) for authorizing an operation of copying the contents from said original recording medium in response to agreement of said combinations but that generates copying non- authorizing information for not authorizing any operation of copying

the contents in response to disagreement of said combinations (“copying process is validated or invalidated in accordance with the current contents of the copy control data Dc”, ¶ [0038]); and

o. a copying authorizing information transmitting operation transmitting said copying authorizing information to said contents copying apparatus (“server apparatus SV sends the copy control data Dc of the relevant contents as a reply”, ¶ [0007]), wherein said copying management method controlling copying of said contents by said contents copying apparatus from said recorded-contents-carrying original recording medium according to said copying authorizing information with respect to each recorded-contents- carrying original recording medium.

p. Also refer to rejection of claim 1 with respect to ‘original medium identification information’ as disclosed by Sako.

19. With respect to claim 11:

20. Hiratsuka discloses a contents copying apparatus (“Personal computers” PCa1, PCa2,..., Figs. 1A and 1B) comprising: a controller configured to acquire medium identifying information specific to and uniquely characterizing one recorded-contents-carrying original recording medium including contents to be copied; the controller further configured to acquire apparatus identifying information (“an apparatus number (PC number)” ¶ [0018]) specific to and indicating said contents copying apparatus itself; a transmission/reception section configured to transmit said medium identifying information and said apparatus identifying information to a copying management device

connected to it by a network as copying-related combination information; the transmission/reception section further configured to receive copying authorizing information generated after registration of said copying-related combination information by said copying management device by comparing said copying-related combination information transmitted at the time of a new access to said copying management device, after the transmitting said medium identifying information, with said copying-related combination information registered in advance, and to authorize an operation of copying the contents from said original recording medium in response to agreement of said combinations of medium identifying information and apparatus identifying information but not authorizing any operation of copying the contents in response to disagreement of said combinations from said copying management device; and the controller further configured to control the operation of copying according to said copying authorizing information. (Also, refer to claim 1 rejection).

21. With respect to claim 3:

22. Sako teaches wherein said medium identifying information is a characteristic of the printing surface of said recorded-contents-carrying original recording medium ("original medium identification information", ¶¶ [0203], [0204], and [0213]) produced at the time of printing, information of the signals on the recording surface of said recorded-contents-carrying original recording medium, the signals recorded on the recording surface, or a combination of one or more of: the characteristic of the printing surface of said recorded-contents-carrying original recording medium ("original medium identification information", ¶¶ [0203], [0204], and [0213]) produced at the time of

printing, information of the signals on the recording surface of said recorded-contents-carrying original recording medium, or the signals recorded on the recording surface.

### ***Response to Arguments***

23. Applicant's arguments with respect to claims 1-12 have been considered but are not persuasive and the claims remain rejected.

24. Applicants while conceding the 'Sako' provides 'details of the original medium identification information' argue that 'the original medium identification information' taught by 'Sako' is not the information that would uniquely identify the recording medium.

25. The Examiner respectfully disagrees.

26. Sako teaches that the 'original recording medium identifying information' is part of the contents copying process. Further, the Applicants claim the process of acquiring medium identifying information by a controller.

27. The Examiner respectfully point to the cited paragraphs of Sako that teach the process of 'extraction of medium identifying information'.

### ***Conclusion***

1. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

2. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. References considered pertinent to Applicants' disclosure are listed on form PTO-892 ("Notice of References Cited"). Unless expressly noted otherwise by the Examiner, all references listed on form PTO-892 are cited in their entirety.

5. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by the Examiner.

a. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the

amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

b. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent 'Objection to the Specification' in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to MURALI K. DEGA whose telephone number is



(571)270-5394. The Examiner can normally be reached on Monday to Thursday 7.00AM to 5.30 PM.

7. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K. Dega/  
Art Unit 3621  
June 27, 2011

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621